

REMARKS

Applicant wishes to thank the Examiner for the attention accorded to the instant application, and respectfully requests reconsideration of the application as amended.

Applicant requests that this amendment submitted under 37 CFR § 1.114 along with a Request for Continued Examination (RCE) be entered and the examination of the application be continued.

Formal Matters

Claims 28, 29, 32, and 33 are pending in the application and all are amended. Specifically, the claims are amended to recite that the message, including the list of network identifiers, is signaled from the mobile communication network, and is received by the user equipment without the user equipment scanning the network. Support for the amendment can be found in the specification on page 5, lines 17-21. Care has been taken to ensure no new matter is being entered.

Rejection of Claims Under 35 U.S.C. §103

Claims 28, 29, and 33 are rejected under 35 U.S.C. § 103(a) as unpatentable over Lynch et al., U.S. Patent No. 5,761,618 (hereinafter “Lynch”) in view of U.S. Patent No. 6,122,503 to Daly (hereinafter “Daly”). Claim 32 was rejected under 35 U.S.C. §103(a) as unpatentable over Lynch in view of Daly and U.S. Patent No. 6,125,280 to Grandhi et al. (hereinafter “Grandhi”). These rejections should be withdrawn based on the comments and remarks herein.

The present application, which is related to techniques for handover from an active network to a selected one of a plurality of potential other networks, describes an alternative to scanning broadly for available networks by teaching a User Equipment that is configured to

receive a list of networks available for a potential handover, e.g., a first list, from the active network to which the User Equipment is connected (specification, page 10, lines 6-8).

Advantageously, the terminal does not have to waste resources scanning.

By contrast, Lynch describes a cellular telephone system having service providers that are identified by System Identification (SIDs) numbers, and that each service provider broadcasts a unique SID (column 1, lines 59-65). A suitably equipped subscriber scans the wireless system operating within proximity to the subscriber unit to determine which service provider is providing service in a physical area to which the subscriber unit has roamed. Lynch does not teach or suggest “receiving of said message occurs without said user equipment searching said mobile communication network” as recited in the claims of the present invention.

Further, both Daly and Grandhi fail to cure the above-described deficiencies of Lynch, and the Examiner does not state otherwise.

It has been held by the courts that to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. See, *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). As illustrated above, the hypothetical combination of Lynch and Daly and Grandhi, taken singly or in any combination, does not disclose or suggest receiving a message on a user equipment without said user equipment searching said mobile communication network, and does not teach or suggest each and every feature of the present invention as recited in claims 28, 29, 32, and 33. Thus *prima facie* obviousness has not been established, so that these claims patentably distinguish over the art of record in the application.

Accordingly, withdrawal of this rejection is respectfully requested.

Conclusion

For at least the reasons set forth in the foregoing discussion, Applicant believes that the Application is now allowable, and respectfully requests that the Examiner reconsider the rejection and allow the Application. Should the Examiner have any questions regarding this Amendment, or regarding the Application generally, the Examiner is invited to telephone the undersigned attorney.

Respectfully submitted,



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